Arguments/Remarks

Claims 1-7, and 9 are pending in this application, and currently stand rejected. Claims 10-12 have been previously cancelled. Reconsideration is respectfully requested.

Claim Objections

In response to the objection, applicants have cancelled claim 8 without prejudice.

Rejections under 35 U.S.C. §112

Claims 1-9 have been rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter applicants regard as the invention. More particularly, the Examiner notes that the terms "unsubstituted or substituted" are indefinite. In response thereto, Applicants note that it is unclear whether the Examiner finds the terms unsubstituted or substituted unclear, or whether the Examiner understands the terms, but finds the claim indefinite because it is unclear what the possible substitutions are.

In either case however, it is clear to one of skill in the art what substitutions are, and which may be used in the presently claimed formula I. The Examiner also rejects the definition of R2 as being indefinite because it did not allow for substitutions on the heterocyclical radical moiety. In response to the rejection to the definition of R2, applicants have amended claim 1 to include the term, "optionally substituted" to modify "heterocyclical radical" per the Examiner's suggestion. The rejection is respectfully traversed.

The Examiner has also rejected claims 1-9 under 35 U.S.C. §112 as failing to comply with the enabling requirement. More particularly, the Examiner notes that only compounds where X-R4 are collectively O-benzyl are exemplified.

Compliance with the enablement requirement however, does not turn on whether an example is disclosed. The specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. See MPEP 2164.02. In the present case, X is disclosed as being O, NH, and S, while R4 is disclosed as a carbon linked R7 group, R7 being one of cyclobutyl, cyclopentyl, cyclohexyl, phenyl, furyl, pyrrolyl, thienyl or pyridyl. Given the disclosed experimental procedure showing the synthesis of O-benzyl compounds, one of skill in the art could certainly make amino and sulphur linked R7 groups as disclosed above. The rejection is respectfully traversed, and withdrawal is requested.

Rejections under 35 U.S.C. §103

Claims 1-9 have been rejected under 25 U.S.C. §103 as being obvious over U.S. Patent No. 6,713,474 to Hirst et al. More particularly, the Examiner notes that the difference between the claimed compound and the reference is the position of the X-R4 on the phenyl ring, the 4 position versus Applicant's 3 position.

In applying the test for obviousness to chemically similar structures, the Court of Appeals Federal Circuit recently laid out a standard in *Takeda Chemical Industries Ltd v. Alphapharm Pty. Ltd.* 83 USPQ2d 1169 (Fed. Cir. 2007). The Court stated, "in many cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish a prima facie case of obviousness. ... in order to find a prima facie case of obviousness (for structurally related compounds), a showing that the 'prior art would have suggested making the molecular modifications necessary to achieve the claimed invention' was also required."

In the present case, Hirst broadly discloses close to 600 compounds which are broadly defined as being protein kinase inhibitors. There are at least 400 enzymes identified as protein kinases. There is no suggestion that the compound buried in column 130 lines 53-55 would inhibit IGF-IR inhibitors, let alone a positional isomer of that compound. The rejection is respectfully traversed, and withdrawal is requested.

Entry of this Response is respectfully requested. The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this response or application.

Respectfully submitted,

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